

REMARKS

The Office Action first addresses the Moore Declaration filed on January 19, 2006, finding it "...insufficient to establish...business success."

As is discussed below, it is not necessary to resolve the issue. However, for completeness, applicants will address this issue, after first addressing the two newly-cited references, Douglas et al. U.S. Patent 6,039,688 ("Douglas"), and Lauffer, U.S. Patent 6,546,374 ("Lauffer").

35 U.S.C. § 102

Claim 40, the only pending independent claim, was rejected for lack of novelty over Douglas. This rejection is in error and should be withdrawn.

Before going into detail, applicants make the over-arching point that the §102 rejection is defective on its face, because it does not even purport to assert that every limitation of Claim 40 can be found in Douglas. Claim 40 contains eleven paragraphs, a) – k), and some of the paragraphs recite more than one limitation. For example, paragraph a) requires both multiple coaches and their access to a common web platform. Paragraphs g) and i) require transmittal of information, and also require that such transmittal be carried out via the Internet. The Office Action mentions only a fraction of the limitations of Claim 40; many limitations (e.g., "scheduled coaching sessions", paragraph d) are simply not mentioned.

It is black-letter law that, for a reference to anticipate a claim, each and every limitation of the claim must be found in the reference. As is noted above, the Office Action does not even assert that all of the limitations of Claim 40 can be found in Douglas.

And some of the limitations of claim 40 which the Office Action does assert are found in Douglas are, in fact, not taught by Douglas.

Douglas Does Not Teach the Invention of Claim 40

All that is required for novelty is that Douglas lack one limitation of Claim 40. Nonetheless, without purporting to be exhaustive, applicants, below, point out limitations of Claim 40 not found in Douglas, including limitations which the Office Action erroneously states are found in Douglas.

Before doing so, applicants believe that it is useful, despite the fact that this is an issue of novelty, not non-obviousness, to briefly discuss the fundamental differences between the invention of Claim 40 and the Douglas reference.

The invention provides interactive, Internet-based coaching that is provided to a plurality of clients. Each client is assigned one of multiple personal coaches who have access to a common web platform. Coach and client meet in real-time, scheduled coaching sessions.

An important feature of the invention is that at least some of the coach-client communications employ Internet technology (including web-based systems) that are not e-mail based. Equally important is the common web platform the coaches use in coaching their clients. These two features, Internet-based client-coach communication, and a common web platform used by the coaches, constitute, in large measure, the reasons the methods of the invention are scaleable, and able to deliver consistent coaching methodology throughout a large corp of coaches.

Douglas, fundamentally, does not even match clients and coaches. Douglas, in contrast, describes a “therapeutic behavior modification system.” that has nothing to do with coaching. In the Douglas system, the primary role of the doctor is not to coach the patient, but to monitor the patient’s progress remotely, and then to modify the patient’s program, also remotely. Although the Douglas system allows for some interaction with patients (as has always been the case with doctors and patients), these interactions are not scheduled coaching sessions, and they do not employ the Internet. Nor does the doctor and the patient work from a common web platform.

Now, with particularity, limitations of Claim 40 not found in Douglas, including limitations referred to in the Office Action, will be enumerated.

First, Claim 40 requires that a company “provide interactive, ongoing coaching to a plurality of clients using...Internet communication...” The Office Action states that Douglas teaches this feature because an HMO carries out this function. This is not

correct. There is no mention anywhere in Douglas of using the Internet for communication. The only mention of the Internet in Douglas is that it is as a source of information for patients. For example, Douglas's abstract states: (T)he individual...can obtain health information from...selected sites on the Internet." Consistent with this statement, the description of Figure 32 states that "(u)sers are provided with hypothetical links...to...Internet sites devoted to providing medical and health-related information." Douglas was well aware of the conventional uses of the Internet; he had not thought of applicants' novel, completely different use of the Internet, i.e., communication between client and coach.

Regarding Claim 40's requirement that multiple coaches have access to a common web platform, the Office Action states that the "experts (coaches)...have access to a common web platform (i.e. internet)..." This is incorrect. The common web platform in the invention is the coaching platform, created by the company, that provides the substantive materials that all of the coaches use to perform their coaching function. The web platform uses the Internet; it is not the Internet. Furthermore, experts who provide specialty information from time-to-time, as in Douglas, are not coaches.

In addition to the claim limitations discussed above which are mentioned in the Office Action, Claim 40 contains additional limitations not found in Douglas.

Claim 40 requires that the coach and client meet in real-time, scheduled coaching sessions. In Douglas's system, the role of the doctor is not to coach the patient, but rather

to monitor the patient's progress (on weight loss, or some other wellness issue) using Douglas's electronic system; the interactions with the patient are not scheduled coaching sessions; they are simply interactions that occur whenever the patient and doctor deem it useful, like any traditional doctor-patient relationship, in which the visits are "scheduled" only in that, presumably, an appointment is made. This, of course, is not what is meant by "scheduled" in Claim 40.

Claim 40 also requires that the client transmit information to the coach via the Internet. Douglas simply does not teach this.

Claim 40 also requires that the client and coach access an Internet file. Douglas does not teach this.

Claim 40 is not anticipated by Douglas. This rejection should be withdrawn.

35 U.S.C. §103

All of the claims were rejected for obviousness over Lauffer in view of Douglas. This rejection should be withdrawn. Lauffer is not prior art to the present application. The present application claims priority from U.S.S.N. 09/415,622, filed on October 12, 1999; this application contains complete support for all the currently pending claims. Lauffer was filed in 2001; on its face, it references a 2000 application as "related," but whether or not the 2000 application describes the techniques of the later Lauffer

application is irrelevant; that application was filed too late to constitute prior art. Because all of the obviousness rejections rely on Lauffer, they must be withdrawn.

Despite the fact that it is unnecessary to discuss Lauffer for the reasons given above, applicants nonetheless point out that the Office Action's characterization of Lauffer is incorrect; Lauffer does not use a web platform to provide ongoing, interactive coaching. Further, Lauffer is concerned with selling products, not with helping clients improve wellness.

The Moore Declaration

As there is no valid obviousness rejection, the question of the weight that should be accorded the Moore Declaration is moot. Nevertheless, applicants note that there are several statements in the Office Action that incorrectly characterize the standard by which such declarations should be judged. For example, the Office Action states that "there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long." The Moore Declaration cites an award (tribute); it is not seen how the above-quoted statement is relevant to the question of whether such tribute constitutes objective evidence of non-obviousness.

Conclusion

In view of the above, it is submitted that all of the claims are in condition for allowance, and such action is requested.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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